

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed December 15, 2009 ("Office Action"). Claims 1-4, 6, 7, 9-19, 21, 22, 24-34, 36-37, and 39-45 are currently pending in this Application, of which claims 1, 16, and 31 are independent. By this Amendment, Applicants have amended claims 1, 10, 16, and 31. The Amendment finds support throughout the specification, including in Figures 1, 2, and 4.

In the Office Action, the Examiner took the following actions:

- (1) rejected claims 1-7, 12-22, 27-37, and 42-45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,901,214 ("*Shaffer*") in view of U.S. Patent Publication No. 2006/0031213 ("*Wilson*"); and
- (2) indicated claims 9-11, 24-26, and 39-41 would be allowable if rewritten in independent form, but objected to those claims as being dependent upon a rejected base claim.

Applicants thank the Examiner for indicating that claims 9-11, 24-26, and 39-41 would be allowable if rewritten in independent form.

Applicants also respectfully traverse the § 103(a) rejections. The Office Action does not establish a *prima facie* case of obvious with regard to claims 1-7, 12-22, 27-37, and 42-45.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The

mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Office Action does not properly determine the scope and content of the prior art or ascertain the differences between the claimed invention and the prior art. Accordingly, it does not clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

A. The cited references do not teach that “the alternate delivery point code contains the same number of digits as the normal delivery point code.”

Amended independent claims 1, 16, and 31 now recite, among other things, “the alternate delivery point code contains the same number of digits as the normal delivery

point code." This amendment is supported throughout the specification, as is apparent, for example, by comparing the delivery point codes of Figures 1 and 2 and following steps, for example, in Figure 4. The cited references do not teach or suggest this subject matter.

The Examiner cites Schaffer for the subject matter related to "creating the alternative delivery point code when the delivery data includes the secondary element." See, e.g., Office Action at 3. However, the alternate delivery point code created by Schaffer is longer than the normal delivery point code:

"Appending the secondary address to the end of the DPC results in an extended 19 digits USPS ZIP Code, thereby creating a unique housing unit or business identifier."

Schaffer at 11:40-44 (emphasis added).

Therefore, Schaffer teaches appending information to the end of a normal delivery point code, which cannot result in an "alternate delivery point code [that] contains the same number of digits as the normal delivery point code," as claimed by Applicants.

Wilson does not cure this deficiency, because Wilson is completely silent with regard to creating an "alternative delivery point code when the delivery data includes the secondary element," as claimed by Applicants. Because it does not teach or suggest an alternate delivery point code, it also does not teach or suggest "the alternate delivery point code contains the same number of digits as the normal delivery point code," as recited in amended claims 1, 16, and 31.

Therefore, no combination of cited references teaches or suggests all the elements of amended independent claims 1, 16, and 31.

B. The cited references do not teach that “creating the alternative delivery point code ... includes converting at least one digit of numeric data in the secondary element into different numeric data.”

Amended independent claims 16 and 31 substantially recite that “creating the alternative delivery point code ... includes converting at least one digit of numeric data in the secondary element into different numeric data.” The Examiner correctly acknowledges *Shaffer* does not teach or suggest these elements, but instead cites paragraph [0006] of *Wilson* as allegedly teaching this subject matter. However, that paragraph, replicated below, is silent with regard to this claimed subject matter:

The above-incorporated parent application "METHOD AND SYSTEM FOR STORING AND RETRIEVING DATA USING HASH-ACCESSED MULTIPLE DATA STORES" provides a secured data store that may contain address information and be distributed to vendors that are not agents supervised by the USPS. However, in order to use the method and system described in the above-referenced patent application, access information must be standardized and filtered (pre-processed) so that the information placed in the data store may be retrieved. While the above-referenced patent application describes a level of pre-processing that obtains an 11-digit delivery point code (DPC) that is used to access the data stores and retrieve associated address information, the DPC must be obtainable from user input or other data entry, such as records in other data stores, before the address information can be accessed.

Wilson at [0006].

The above paragraph mentions “a level of pre-processing that obtains an 11-digit delivery point code (DPC) that is used to access the data stores and retrieve associated address information.” However, this does not constitute or suggest Applicants’ claimed subject matter because it has nothing to do with “creating the alternative delivery point code” or “converting at least one digit of numeric data in the secondary element into different numeric data,” as claimed. The rest of *Wilson* is also silent with regard to this subject matter.

Consequently, no combination of *Shaffer* and *Wilson* discloses, teaches or suggests "creating the alternative delivery point code ... includes converting at least one digit of numeric data in the secondary element into different numeric data," as recited in amended independent claims 16 and 31. Therefore, at least this additional basis for allowance exists for those claims.

C. The cited references do not teach "when the secondary element contains alphanumeric data, converting the alphanumeric data to numeric data."

Amended independent claim 1 recites "when the secondary element contains alphanumeric data, converting the alphanumeric data to numeric data." The Examiner correctly concludes that *Shaffer* does not teach or suggest this subject matter. Office Action at 4.

However, the Examiner instead cites claim 36 of *Wilson* as allegedly teaching this subject matter, presumably because it recites "converting alphabetical representations of numbers in the second identifier component to numeric values." However, this does not constitute or suggest the above claimed subject matter because the conversion does not relate to a "secondary element." Instead, the conversion taught by *Wilson* of the "second identifier" is "associated with a name" rather than with an "address," as explicitly indicated by *Wilson*'s claim 33 (emphasis added). Therefore, the conversion taught by *Wilson* does not pertain to a "secondary element" of delivery data, as claimed by Applicants. The rest of *Wilson* is also silent with regard to the claimed subject matter.

Consequently, no combination of *Shaffer* and *Wilson* discloses or suggests "when the secondary element contains alphanumeric data, converting the alphanumeric

data to numeric data," as recited in amended independent claim 1. Therefore, at least this additional basis for allowance exists for claim 1.

D. No *prima facie* case of obviousness

In view of at least these shortcomings of *Shaffer* and *Wilson*, the Office Action does not properly determine the scope and content of the prior art or explain why the differences between the cited references and amended claims 1, 16, and 31 would have been obvious to one of ordinary skill in the art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 16, and 31, and the rejections under 35 U.S.C. § 103(a) must be withdrawn. For the same reasons, claims 2-4, 6-7, 9-15, 17-19, 21-22, 24-30, 32-34, 36-37, and 39-45¹ are also allowable at least due to their dependence from independent claims 1, 16, and 31.

Conclusion²

In view of the foregoing remarks, Applicants submit that the pending claims, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request that the Examiner reconsider and withdraw the rejections and objections to the pending claims and pass this application to issue.

¹ Accordingly, dependent claims 9-11, 24-26, 29-30, 32-34, and 36-41 do not depend on a properly rejected base claim, and Applicants submit that the objection to these claims is overcome for at least these reasons.

² It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 15, 2010

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